

REMARKS

Claims 1-30 are pending in this application.

Claims 1-4, 9-14, 19-24 and 29-30 have been rejected.

Claims 5-8, 15-18 and 25-28 have been objected to.

Claims 1,7, 10, 11, 17, 20, 21 and 30 have been amended.

Allowance of Claims 1-30, as amended, is respectfully requested.

I. ALLOWABLE SUBJECT MATTER

In Paragraph 8 on Page 6 of the January 9, 2006 Office Action the Examiner stated that "Claims 5-8, 15-18, 25-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims." The Applicants thank the Examiner for the indication that these claims would be allowable if rewritten as requested. For the reasons set forth below, the Applicants respectfully submit that Claims 5-8, 15-18, 25-28 (and all other pending claims) are allowable. Therefore, the Applicants respectfully request that Claims 5-8, 15-18 and 25-28 be passed to issue.

II. REJECTIONS UNDER 35 U.S.C. § 112

In Paragraphs 3 and 4 on Page 2 of the January 9, 2006 Office Action the Examiner stated that Claims 1, 10-11 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The claims were said to be indefinite due to the presence of the phrase “capable of” in the claims. In addition, Claim 1 was rejected for having insufficient basis for the limitation “said work” in Line 15. In response, the Applicants have amended the claims to remove the phrase “capable of” and have amended the limitation in Claim 1 to read “said work flow record.” The Applicants respectfully submit that these amendments to the claims overcome the rejections under 35 U.S.C. § 112. The Applicants respectfully request that the rejections under 35 U.S.C. § 112 be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. § 103(a)

The January 9, 2006 Office Action rejected Claims 1-2, Claims 9-12, Claims 19-22, and Claims 29-30 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,067,525 to Shkedy (hereafter “*Shkedy*”) in view of United States Patent No. 5,301,320 to McAtee et al. (hereafter “*McAtee*”). The January 9, 2006 Office Action also rejected Claims 3-4, Claims 13-14, and Claims 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Shkedy* and *McAtee* in view of United States Patent No. 6,073,109 to Flores et al. (hereafter “*Flores*”). The Applicants respectfully traverse these rejections.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The Applicants respectfully direct the Examiner's attention to amended Claim 1, which sets forth unique and novel claim elements:

1. (Currently Amended) For use in connection with a network that provides communications between a plurality of customers generating service requests and a plurality of vendors that fulfill said service requests, a system for monitoring and controlling work flows associated with said service requests between said plurality of customers and said plurality of vendors comprising:

a main controller that creates a first work flow record used to control a first work flow associated with a first service request and that stores said first work flow record in a storage device associated with said main controller, wherein said main controller receives from a first customer within said plurality of customers and a first vendor within said plurality of vendors, said first customer and said first vendor associated with said first work flow, at least one of messages, data files, software applications, and documents, and stores said at least one of messages, data files, software applications, and documents in said storage device in association with said work flow record, and transfers at least one of said at least one of messages, data files, software applications, and documents to at least one of said first customer and said first vendor, wherein said first work flow is at least partially developed or executed by said receiving, storing and transferring said at least one of messages, data files, software and documents; and

an accounting controller associated with said main controller that identifies at least one fee associated with said first work flow and that stores fee data associated with said at least one fee in said first work flow record. (Emphasis added).

With respect to independent Claim 1, the Examiner stated that "Shkedy discloses a systems and methods for providing a global bilateral buyer-driven system for creating binding contracts between sellers and buyers. In doing so, Shkedy discloses a main controller 'i.e. a central controller for receiving a forward purchase order from and creating' capable of creating a first work flow record used to control a first work flow associated with a first service request and storing said first work flow record in a storage device associated with said main controller" (January 9, 2006 Office Action, Page 3, Lines 13-18). For the reasons set forth below, the Applicants respectfully disagree with the Examiner's characterization of the *Shkedy*

reference as disclosing a main controller that is capable of creating “a first work flow record” for controlling “a first work flow” of the type disclosed and claimed by the Applicants. In addition, the Applicants respectfully disagree with the remainder of the Examiner’s characterization of the *Shkedy* reference (January 9, 2006 Office Action, Page 3, Line 19 to Page 4, Line 7).

The *Shkedy* reference recites systems and methods for creating binding contracts in a buyer-driven system. (*Shkedy*, Abstract). Orders from individual buyers may be combined into a single collective purchase requirement, and sellers willing to bid on the purchase requirement are located. (*Shkedy*, Abstract). A central controller manages the operation of the system. (*Shkedy*, Abstract).

Specifically, the *Shkedy* reference discloses a system in which each buyer has a buyer interface 400 that is connected to a central controller 200 via a buyer modem 450. Similarly, each seller has a seller interface 300 that is connected to the central controller 200 via a seller interface 350. Each buyer interface 400 comprises a central processor unit (CPU) 405. Each seller interface 300 comprises a central processor unit (CPU) 305. These hardware components do not carry out the functions of the Applicants’ “main controller” or the functions of the Applicants’ “accounting controller.”

The *Shkedy* network “facilitates communications between a plurality of buyers and a plurality of sellers through an intermediary (i.e. central controller 200).” (Emphasis added) (*Shkedy*, Column 4, Lines 62-65). All communications between a buyer and a seller in *Shkedy* are indirect and must be mediated by the central controller 200. FIGURE 2 of *Shkedy* shows

database storage device 250 in central controller 200. Database storage device 250 contains various databases for mediating the communications between buyers and sellers.

Consider, for example, that *Shkedy* states: “The buyer logs on to central controller 200, selects the item that he wishes to purchase, accepts the maximum price given by the central controller 200 and thereby creates FPO 100 [Forward Purchase Order 100], and then disconnects from the network.” (Emphasis supplied) (*Shkedy*, Column 12, Lines 59-62). Seller bids 115 are transmitted electronically to central controller 200. When the optimal bid has been determined [by the central controller 200], the central controller 200 contacts the buyer and seller to indicate that they are mutually bound.” (Emphasis added) (*Shkedy*, Column 12, Line 67 to Column 13, Line 3).

Shkedy does not disclose the concept of a customer (buyer) transferring messages, data files, software applications and documents to a vendor (seller) through a main controller in response to a vendor inquiry. “After a work flow is initially created, customer transfer controller 212 and customer data collection controller 212 continue to interact with the operator of customer network 110 during subsequent sessions with RCE network 180. For example, a vendor may respond to a service request in a work flow by asking one or more questions or requesting additional documents from customer network 110.” (Specification, Page 29, Lines 12-18) (Emphasis added). “Alternatively, the vendor may decide to accept the work flow or may decide to ask for additional information and/or documents from the customer that generated the work flow.” (Specification, Page 30, Lines 8-10) (Emphasis added).

The example of a vendor asking one or more questions or requesting additional documents is inherent in the claim language of Claim 1 that states “wherein said main controller receives from a first customer within said plurality of customers and a first vendor within said plurality of vendors, said first customer and said first vendor associated with said first work flow, at least one of messages, data files, software applications, and documents, and stores said at least one of messages, data files, software applications, and documents in said storage device in association with said work flow record, and transfers at least one of said at least one of messages, data files, software applications, and documents to at least one of said first customer and said first vendor . . .”

Similarly, *Shkedy* does not disclose the concept of a vendor (seller) transferring messages, data files, software applications and documents to a customer (buyer) through a main controller. “Advantageously, the vendor may, for a price, allow a customized vendor work flow application 236 to be exported to RCE network 180, network 110, or both.” (Specification, Page 31, Lines 4-8) (Emphasis added). Further, “After a work flow is accepted by the vendor, vendor transfer controller 232 and vendor data collection controller 234 continue to interact with the vendor during subsequent sessions with RCE network 180. For example, a vendor may from time to time ask questions or request additional documents from customer network 110. In this case, vendor transfer controller 232 and vendor data collection controller 234 continue to operate as before, gathering information from the vendor operating vendor network 150 and transmitting it to RCE network 180.” (Specification, Page 34, Lines 12-20) (Emphasis added).

In this aspect of the invention, RCE network 180 serves as a conduit for direct communications between customer transfer controller 212 and vendor transfer controller 232. It is clear that RCE network 180 is not a required link in the communication path between customer transfer controller 212 and vendor transfer controller 232 for all communications. This is shown by the statement “Advantageously, the vendor may, for a price, allow a customized vendor work flow application 236 to be exported to RCE network 180, network 110, or both.” (Specification, Page 31, Lines 4-8). That is, the vendor may (or may not) communicate with the customer network 110 via RCE network 180. FIGURE 1 illustrates that each vendor unit (e.g., 150) has direct access to each customer unit (e.g., 110) through communication network 140.

Shkedy does not disclose, suggest or even hint at the Applicants’ concept of a customer (buyer) transferring messages, data files, software applications and documents to a vendor (seller) through a main controller in response to a vendor inquiry. *Shkedy* also does not disclose, suggest or even hint at the Applicants’ concept of a vendor (seller) transferring messages, data files, software applications and documents to a customer (buyer) through a main controller.

The Applicants respectfully note that the *Shkedy* reference fails to disclose significant elements of the Applicants’ invention. Therefore, the *Shkedy* reference provides an insufficient basis for use as a prior art reference against the Applicants’ invention. For these reasons, the Applicants’ invention, as claimed in independent Claim 1 (and in the dependent claims) is not obvious in view of the *Shkedy* reference.

A previous Office Action dated November 13, 2003 acknowledged that *Shkedy* fails to disclose “executing a workflow upon receiving a message.” (November 12, 2003 Office Action, Page 3, Third Paragraph). In fact, *Shkedy* fails to mention using any type of workflows, and the present Office Action (January 9, 2006 Office Action) has not provided any motivation or suggestion as to why one skilled in the art would modify *Shkedy* to include the use of workflows.

The present Office Action stated that “*Shkedy* does not explicitly disclose wherein said work flow is at least partially executed by said receiving, storing and transferring said at least one message.” (January 9, 2006 Office Action, Page 4, Lines 8-9). The Office Action then asserted that the *McAtee* reference discloses these elements and that it would be obvious to modify *Shkedy* with the recitations of *McAtee* (January 9, 2006 Office Action, Page 4, Lines 9-16). The Applicants respectfully traverse these assertions.

The *McAtee* reference discloses a computerized system for automatically executing a plurality of business tasks while allocating resources based on availability and priority. A sequential order of work steps called a “workflow” is designed in advance by a designer. A designer first defines a workflow by providing the system with a template of business activities. After the designer completes the template the system performs the various tasks in the order in which they tasks are specified in the workflow template. (*McAtee*, Column 2, Lines 33-49). A user can initially enter data (*McAtee*, Column 12, Lines 51-52) or send an indication that a manual task has been completed (*McAtee*, Column 4, Lines 51-55). However, the sequential order of the *McAtee* workflow is not “partially developed or executed” by “transferring at least one of said at least one of messages, data files, software applications, and

documents to at least one of said first customer and said first vendor" as recited in Claim 1, Claim 11 and Claim 21.

The Office Action asserts that it would be obvious to modify *Shkedy* with the recitations of *McAtee* "with the motivation to execute monitor and control the flow of business operations." (January 9, 2006 Office Action, Page 4, Lines 15-16). However, as previously mentioned, *Shkedy* lacks any mention of using any type of workflow. The Office Action has failed to establish that the workflow functionality is needed or even desired in the system of *Shkedy*. Without that showing, the Office Action cannot establish that a person skilled in the art would modify *Shkedy* with the recitations of *McAtee* as asserted in the Office Action.

There is nothing in the *Shkedy* reference that suggests combining the teachings of the *McAtee* reference with the teachings of the *Shkedy* reference. There is nothing in the *McAtee* reference that suggests combining the teachings of the *Shkedy* reference with the teachings of the *McAtee* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The motivation to "execute, monitor and control the flow of business operations" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some

teaching or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembicza*k, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Roufett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

The Applicants respectfully submit that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicants respectfully submit that the alleged motivation to combine references is not clear and particular. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicants respectfully submit that the alleged motivation to

combine references has been assumed by “hindsight” in light of the existence of the Applicants’ invention.

For the reasons previously set forth, the Applicants respectfully disagree with the Examiner’s characterization of the *Shkedy* system as set forth in the *Shkedy* reference. Therefore, even if it were proper (which the Applicants do not admit) to combine the *Shkedy* system and the *McAtee* system, the combination of the two references would still not teach, suggest or even hint at the Applicants’ invention.

Therefore, the Applicants’ invention would not have been obvious in view of the teachings of the *Shkedy* reference in view of the *McAtee* reference. The Applicants respectfully submit that Claims 1, 10, 11, 20, 21 and 30 each contain unique and novel claim limitations and that Claims 1, 10, 11, 20, 21 and 30 are now in condition for allowance. Further, the dependent claims that depend, directly or indirectly, on independent 1, 10, 11, 20, 21 and 30 also contain the unique and novel claim limitation of their respective independent claims. Therefore, the dependent claims that depend, directly or indirectly, on Claims 1, 10, 11, 20, 21 and 30 also contain patentable subject matter and are in condition for allowance.

For the reasons set forth above, the Applicants respectfully traverse the assertions in the Office Action that it would have been obvious to modify the *Shkedy* reference with the teachings of the *McAtee* reference to reject Claim 2. There is no mention in either *Shkedy* or *McAtee* of “a plurality of work flow definitions defining at least one process step to be performed by at least one of said main controller, said accounting controller, a first customer processing device associated with said first customer, and a first vendor processing device associated with said first

vendor." There is nothing in the *McAtee* reference that supplies the deficiencies of the *Shkedy* reference with respect to Claim 2.

For the reasons set forth above, the Applicants respectfully traverse the assertions in the Office Action that it would have been obvious to modify the *Shkedy* reference with the teachings of the *McAtee* reference to reject Claim 12. There is no mention in either *Shkedy* or *McAtee* of a work flow record that comprises a plurality of work flow definitions defining at least one process step to be performed by at least one of said main controller, said accounting controller, a first customer processing device associated with said first customer, and a first vendor processing device associated with said first vendor. There is nothing in the *McAtee* reference that supplies the deficiencies of the *Shkedy* reference with respect to Claim 12.

There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The motivation to "execute, monitor and control the flow of business operations" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings with respect to Claim 12.

The January 9, 2006 Office Action also rejected Claims 3-4, Claims 13-14, and Claims 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Shkedy* and *McAtee* and in view of United States Patent No. 6,073,109 to Flores et al. (hereafter "*Flores*"). The Applicants respectfully traverse these rejections.

For the reasons set forth above and for the reasons set forth below, the Applicants respectfully traverse the assertions in the Office Action that it would have been obvious to

modify teachings of the *Shkedy* reference and the teachings of the *McAtee* reference with the teachings of the *Flores* reference to reject Claim 3, Claim 4, Claims 13-14 and Claims 23-24. For the reasons set forth above, neither the *Shkedy* reference nor the *McAtee* reference (nor the two references in combination) teach the unique and novel elements of the Applicants' invention. Furthermore, the deficiencies of the *Shkedy* reference and the *McAtee* reference are not remedied by the *Flores* reference.

With respect to Claim 3, Claim 4, Claims 13-14 and Claims 23-24, the Office Action acknowledges that the combination of the *Shkedy* and *McAtee* references fails to explicitly disclose "which party modifies the work order or the work plan." (January 9, 2006 Office Action, Page 5, Line 21). The Office Action then asserts that it would be obvious to modify the work flow definitions "in order to have a dynamic or a flexible system." (January 9, 2006 Office Action, Page 6, Lines 3-4). The Applicants respectfully traverse these assertions. The motivation to "to have a dynamic or a flexible system" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings with respect to Claim 3, Claim 4, Claims 13-14 and Claims 23-24.

The Office Action also asserts that Claim 3, Claim 4, Claims 13-14 and Claims 23-24 are obvious in view of the teachings of *Shkedy* and *McAtee* as modified by the teaching of *Flores*. (January 9, 2006 Office Action, Page 6, Lines 7-11). The Applicants respectfully traverse these assertions. The Applicants hereby incorporate by reference all of the arguments previously made in connection with Applicants' position concerning the *Shkedy* reference and the *McAtee* reference.

The Applicants respectfully traverse the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of *Shkedy* and *McAtee* to include a workflow definitions modification as taught by *Flores*.

First, the supposed motivation to obtain "to create, modify and delete definition documents in a database" is very general and does not specifically suggest combining the teachings of the *Flores* reference with the teachings of the *Shkedy* reference and the *McAtee* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire "to create, modify and delete definition documents in a database" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. The *Flores* reference does not disclose any features that would cure the deficiencies of the *Shkedy* reference or the deficiencies of the *McAtee* reference.

For these reasons, the Office Action has not shown that a person skilled in the art would be motivated to combine *Shkedy* and *McAtee* references or be motivated to combine the *Shkedy* and *McAtee* and *Flores* references as asserted in the Office Action. As a result, the Office Action has not established a *prima facie* case of obviousness against Claims 1-30. Accordingly, the Applicants respectfully submit that Claims 1-30 are in condition for allowance. Allowance of Claims 1-30 is respectfully requested.

IV. CONCLUSION

**DOCKET NO. I20 25302 US (HWEL01-25302)
SERIAL NO. 09/474,948
PATENT**

The Applicants' attorney has made the arguments set forth above in order to place this application in condition for allowance. In the alternative, the Applicants' attorney has made the amendments and arguments to properly frame the issues for appeal. In this Response, the Applicants make no admission concerning any now moot rejection or objection, and affirmatively deny any position, statement or averment of the Examiner that was not specifically addressed herein.

DOCKET NO. I20 25302 US (HWEL01-25302)
SERIAL NO. 09/474,948
PATENT

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK BUTRUS, P.C.

Date: April 10, 2006



William A. Munck
Registration No. 39,308

P.O. Box 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@davismunck.com*